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First Named Inventor

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Art Unit

3627

Examiner Name

Fischer, Andrew J.

Attorney Docket Number

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AUS920010855US1  
APPEAL BRIEF

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
William K. Bodin, *et al.*

Serial No.: 10/062,325

Filed: January 31, 2002

Title: Inventory Controls with Radio  
Frequency Identification

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Group Art Unit: 3627

Examiner: Fischer, Andrew J.

Atty Docket No.: AUS920010855US1

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Catherine Berglund  
Catherine Berglund

**APPEAL BRIEF**

**Honorable Commissioner:**

This is an Appeal Brief filed pursuant to 37 CFR § 41.37 in response to the Final Office Action of July 22, 2005 ('Final Office Action'), and pursuant to the Notice of Appeal filed October 24, 2005.

**REAL PARTY IN INTEREST**

The real party in interest is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

## **RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

## **STATUS OF CLAIMS**

Claims 1-30 are pending in the case. All pending claims are on appeal.

## **STATUS OF AMENDMENTS**

No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

Applicants provide the following concise summary of the claimed subject matter according to 37 CFR§ 41.37(c)(1)(vii), including references to specification by page and line number and to the drawing(s) if any, by reference characters.

Methods, systems, and products of inventory control, typically including providing inventory item attributes comprising data elements in computer memory, wherein the inventory item attributes describe an inventory item, the inventory item has an RFID identification tag having an RFID identification tag code, and the inventory item attributes typically include an RFID identification tag code field, a control value, an acceptable control value range, and an out of range action (described for example on page 15, lines 17-25 with reference to Figure 2 at references 220, 300, 117, 114, 210, 306, 308, 312, 314). Some exemplary embodiments include detecting changes in the inventory item attributes, wherein detecting changes in inventory item attributes includes reading, through an RFID reader, the RFID identification code from the RFID tag associated with the inventory item, recording detected changes in inventory item attributes, comparing the control value and the acceptable control value range, and taking action in dependence

upon the result of the comparing and the out of range action (described for example on page 15, line 25, through page 16, line 11, with reference to Figure 2, at references 206, 208, 110, 210, 117, 222).

All such references to the specification identify descriptions and discussions that are part of the detailed descriptions of exemplary embodiments of the present invention in the present application. Such descriptions and discussions are not limitations of the claims in the present application. The only limitations of the claims are set forth in the claims themselves.

### **GROUND OF REJECTION**

The Final Office Action objects to the specification for failing to provide a proper antecedent basis for the claimed subject matter under 37 C.F.R. § 1.75(d)(1), MPEP § 608.01(o), and MPEP § 2181IV. As explained in detail below, Applicants respectfully traverse the objection to the specification.

Claims 1-30 stand rejected under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. As explained in detail below, Applicants respectfully traverse the rejections of the present claims 1-30 under 35 U.S.C § 112, second paragraph.

Claims 11-20 stand rejected under 35 U.S.C § 102(e) as being anticipated by Reber, *et al.* (U.S. Patent No. 5,798,694). As explained in detail below, Applicants respectfully traverse the rejections of the present claims 11-20 under 35 U.S.C § 102(e).

Claims 1-30 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Reber, *et al.* (U.S. Patent No. 5,798,694) over Well Known Prior Art. As explained in detail below, Applicants respectfully traverse the rejections of the present claims 1-30 under 35 U.S.C § 103(a).

## **ARGUMENT**

### **A RESTRICTION IS IMPROPER**

Applicants acknowledge with gratitude the Examiner's conclusion in numbered paragraph 2 of the Final Office Action that "a restriction is improper at this time."

### **THE OBJECTION TO THE SPECIFICATION IS IMPROPER**

The Final Office Action objects to the specification for failing to provide a proper antecedent basis for the claimed subject matter under 37 C.F.R. § 1.75(d)(1), MPEP § 608.01(o), and MPEP § 2181IV. The Final Office Action at paragraph 6 states:

The claims are replete with these errors (these errors being objections to the specification for failing to provide proper antecedent basis for the claimed subject matter). Some examples follow:

- a. The "means for providing" as recited in claims 11 and 21
- b. The "means for detecting" as recited in claims 12 and 22
- c. The "means for reading" as recited in claims 14 and 24

The bare assertion that the "claims are replete with these errors" gives the applicants inadequate notification of the reasons for the objection. 35 U.S.C. § 132 requires the Examiner to notify the applicants of the reasons for an objection, including "such information and references as may be useful in judging of the propriety of continuing the prosecution...." 37 C.F.R. § 1.104(c)(2) second sentence requires, "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." MPEP § 707 requires, when needed for compliance with 35 U.S.C. § 132, the inclusion in the Final Office Action of "...the particular figures(s) of the drawing(s), and/or page(s) or

paragraph(s) of the reference(s)....” In this Final Office Action, the assertion that the “claims are replete with these errors” is accompanied by no explanation whatsoever of what ‘these errors’ are. Without knowing any reason for the objection, the Applicants cannot understand the basis for the objection. The objection therefore fails to meet the requirements of 35 U.S.C. § 132 and should be withdrawn.

Because the Final Office Action does not comport with 35 U.S.C. § 132 to give enough information for the Applicants to fashion a response to the Final Office Action, Applicants are under no obligation to respond further. Nevertheless, in an effort to move the case forward, Applicants will attempt to provide meaningful comment regarding the three means claims mentioned in paragraph 6 of the Final Office Action. Applicants’ legal obligation regarding enablement of means claims is set forth in MPEP § 2181 which states, “37 CFR 1.75(d)(1) provides, in part, that ‘the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.’” *Manual of Patenting Examination Procedure* § 2181IV. In determining whether a means-plus-function has support in the written description, “[t]he proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function.” *Manual of Patenting Examination Procedure* § 2181 II (citing *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999)).

The means claims specifically mentioned in paragraph 6 of the Final Office Action, claims 11, 12, 14, 21, 22, and 24, are in fact well enabled in the specification:

- The limitation “means for providing” from claims 11 and 12 is enabled, for example, at least at the following locations: in the specification beginning at line 4 of page 2 and beginning at line 34 of page 10, referencing Figure 2.

- The limitation “means for detecting” from claims 12 and 22 is enabled, for example, at least at the following locations: in the specification beginning at line 15 of page 2, beginning at line 12 of page 11, referencing Figure 2, and beginning at line 34 of page 11, referencing Figure 4.
- The limitation “means for reading” from claims 14 and 24 is enabled, for example, at least at the following locations: in the specification beginning at line 11 of page 2, beginning at line 5 of page 11, referencing Figure 2, and beginning at line 37 of page 11, referencing Figure 4.

In view of the detailed descriptions in the specification, it is clear that the specification provides clear support or antecedent basis within the meaning of 37 CFR 1.75. The Applicants therefore traverse the objection to the specification, and respectfully request the withdrawal of the objection.

**REJECTIONS FOR CLAIMS 1-30 UNDER 35 U.S.C. § 112,  
2<sup>ND</sup> PARAGRAPH, ARE IMPROPER**

Claims 1-30 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Final Office Action at paragraph 9 states:

- i. In claim 1, it is unclear if the “detecting changes” detects changes to the attribute definitions (as claimed) or changes in the ‘values’ of the attributes. In other words, what “changes” are being detected? Are there changes to the attribute definition or type of attribute, a value of the attribute, or some other change?
- ii. In claim 11 and 21, it is unclear what is the corresponding structure in the ‘means for detecting changes....’ In particular, it is unclear which

hardware and/or software elements make up the “means for detecting changes....”

- iii. Also in claim 12, the term “OSGI” is indefinite. If Applicants expressly state on the record that such a term is old and well known in the art and Applicants provide appropriate evidence in support thereof, this particular 35 U.S.C. § 112, 2<sup>nd</sup> paragraph rejection will be withdrawn.

MPEP § 2173 sets forth the standard for compliance with 35 U.S.C. § 112 stating that “...the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.” *Manual of Patenting Examination Procedure* § 2173.02; *See Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). MPEP § 2173 further explains, “Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teaching of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” *Manual of Patenting Examination Procedure* § 2173.02.

The examples specifically mentioned in paragraph 9 of the Final Office Action, claims 1, 11, 12, and 21, do in fact properly satisfy the definiteness requirement of 35 U.S.C. § 112, second paragraph, when analyzed in light of the factors from MPEP § 2173 above, including the Applicants’ disclosure:

- The limitation “detecting changes” from claim 1 is definite in light of Applicants’ disclosure, for example, at least at the following locations: in the specification beginning at line 23 of page 2, beginning at line 4 of page 17, referencing Figure 4, and beginning at line 19 of page 17, referencing Figure 5.



- The limitation “means for detecting changing” from claims 11 and 21 is definite in light of Applicants’ disclosure, for example, at least at the following locations: in the specification beginning at line 7 of page 16, referencing Figures 1 and 2, beginning at line 24 of page 11, beginning at line 14 of page 11, referencing Figure 1, beginning at line 11 of page 7, and beginning at line 4 of page 17.
- The limitation “OSGI” from claim 12 is definite in light of Applicants’ disclosure, for example, at least at the following locations: in the specification beginning at line 9 of page 12.

In view of the detailed descriptions in the specification, it is clear that the claim language is sufficiently definite to apprise one of ordinary skill in the art of its scope as required by 35 U.S.C. § 112, second paragraph. The Applicants therefore traverse the rejections individually to claims 1-30 under 35 U.S.C. § 112, second paragraph, and respectfully request the withdrawal of the rejections.

**REJECTIONS OF CLAIMS 11-20 UNDER 35 U.S.C. § 102 AS BEING  
ANTICIPATED BY REBER ARE IMPROPER**

Claims 11-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Reber, *et al.* (U.S. Patent No. 5,798,694). As discussed in further detail below, Applicants respectfully submit in response that the Final Office Action fails to provide the Applicants with information sufficient to judge the propriety of continuing prosecution as required by 35 U.S.C. § 132. In addition, the Final Office Action does not establish anticipation by Reber because the Final Office Action does not even mention many of the elements of the Applicants’ claims. Moreover, examining the substance of Reber confirms that Reber does not anticipate each and every element of the Applicants’ claims in the present application. Finally, the theory of inherency is not available as a basis for rejection of claims in the present case. For these reasons, the rejections should be withdrawn and the claims should be allowed.

**The Final Office Action Fails To Provide The Applicants With  
Information Sufficient To Judge The Propriety Of  
Continuing Prosecution As Required By 35 U.S.C. § 132**

The Final Office Action at numbered paragraph 13 sets forth the following omnibus rejection of most of the elements of claim 11 over Reber:

Claims 11-20 are rejected under 35 U.S.C. §102(e) as being anticipated by Reber et. al. (U.S. 5,798,694)(“Reber”). Reber discloses means for providing inventory item attributes comprising data attributes wherein the inventory item attributes describe an inventory item (the tag must have attributes to separate it from other tags; RFID identification tag 30 and code field (inherent), the RFID tag detects changes, records changes, compares control values with acceptable values, and takes action if those actions are outside a range...

The mere assertion that Reber anticipates claims 11-20 does not give the Applicants adequate notification of the reasons for the rejection. 35 U.S.C. § 132 requires the Examiner to notify the applicants of the reasons for the rejections, including “such information and references as may be useful in judging of the propriety of continuing the prosecution....” 37 C.F.R. § 1.104(c)(2) second sentence requires, “When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.” MPEP § 707 requires, when needed for compliance with 35 U.S.C. § 132, the inclusion in the Final Office Action of “...the particular figures(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s)....” MPEP § 707.07(d) warns against such omnibus rejections as made in the Final Office Action as, “...stereotyped and usually not informative and should therefore be avoided.” In this Final Office Action, the assertion that Reber anticipates claims 11-20 of the present application is accompanied by no

explanation whatsoever of where in Reber the information relied on by the Examiner may be found. Reber describes, among other things:

- food storage apparatus
- a container for containing a food item
- a first electrical component associated with the container
- a second electrical component associated with the cover
- the first electrical component communicating with the second electrical component
- communication between electrical components when the cover seals the opening of the container
- the cover that includes a first at least one electrical contact and the container includes a second at least one electrical contact to provide an electrical coupling between the first electrical component and the second electrical component when the cover seals the opening of the container
- one of the first electrical component and the second electrical component includes a sensor, and another of the first electrical component and the second electrical component includes an indicator
- one of the first electrical component and the second electrical component includes at least one of a receiver, a transmitter, a processor, and a memory, and another of the first electrical component and the second electrical component includes an indicator

- one of the first electrical component and the second electrical component includes at least one of a receiver, a transmitter, a processor, and a memory.
- container sized for carrying by an individual
- container has a capacity less than or equal to 10 liters
- determining a first time at which the food item is removed from the storage place
- determining a second time at which the food item is returned to the storage place
- determining time duration that the food item is outside of a storage place

Reber is a complex reference containing information regarding many technical subjects and other inventions. In this circumstance, it is important for the Final Office Action to provide some indication of where in Reber the Examiner believes elements of Applicants' claims to be disclosed in order for Applicants to have enough information to judge how or whether to continue the prosecution of the present application. Moreover, in the absence of any indication of where within Reber the Examiner believes elements of Applicants' claims to be disclosed or suggested, Applicants cannot understand the reasons for the rejections. For these reasons alone, the rejection of the claims 11-20 should be withdrawn, and the claims should be allowed.

**Final Office Action Has Not Established Anticipation  
By Reber Because The Final Office Action Does Not  
Even Mention Many Of The Elements Of The  
Applicants' Claims**

In the absence of any indication of where in Reber the Examiner believes elements of Applicants' claims to be disclosed, Applicants are under no obligation to comment further regarding the rejections of claims under 35 U.S.C. § 102. Nevertheless, in an

effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants point out with respect that the Final Office Action has not established anticipation by Reber because the Final Office Action does not even mention many of the elements of the Applicants' claims.

As stated in *Verdegaal Bros. v. Union Oil Co. of California*, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The rejected claims 11-20 contain the following elements and limitations:

- means for providing inventory item attributes comprising data elements in computer memory, wherein the inventory item attributes describe an inventory item, the inventory item has an RFID identification tag having an RFID identification tag code, and the inventory item attributes comprise:
  - an RFID identification tag code field,
  - a control value,
  - an acceptable control value range, and
  - an out of range action
- means for detecting changes in the inventory item attributes, wherein means for detecting changes in inventory item attributes include means for reading, through an RFID reader, the RFID identification code from the RFID tag associated with the inventory item
- means for recording detected changes in inventory item attributes

- means for comparing the control value and the acceptable control value range
- means for taking action in dependence upon the result of the comparing and the out of range action
- wherein the means for detecting changes, means for recording detected changes, means for comparing the control value and the acceptable control value range, and means for taking action are carried out through Java servlets in at least one OSGI-compliant service bundle installed and operating in an OSGI-compliant service gateway
- wherein the inventory item attributes further comprise a control value unit field set to 'pounds'
- wherein means for detecting changes includes means for reading the weight of the inventory item from a scale
- wherein means for recording detected changes comprises means for storing the weight of the inventory item in the control value
- wherein the inventory item attributes further comprise a control value unit field set to 'freshness'
- wherein means for detecting changes in the inventory attributes of the inventory item further comprises:
  - means for reading from a clock the time when the inventory item is removed from a refrigerator,
  - means for reading the temperature from a kitchen thermometer,

- means for reading from the clock the time when the inventory item is returned to the refrigerator, and
  - means for calculating a freshness coefficient in dependence upon the time when removed, the time when returned, and the temperature
- wherein means for recording detected changes comprises means for storing the freshness coefficient in the control value
- wherein the inventory item attributes further comprise a control value unit field set to 'utilization'
- wherein means for detecting changes in the inventory attributes of the inventory item includes means for detecting that the inventory item has been removed from and returned to an inventory storage location
- wherein means for recording detected changes comprises means for incrementing the control value, wherein the control value represents the number of times the inventory item has been utilized
- wherein the inventory item comprises a quantity of separate items
- wherein the inventory item attributes further comprise a control value unit field set to 'count'
- wherein means for detecting changes in the inventory attributes includes means for detecting that one of the separate items has been removed from inventory

- wherein means for recording detected changes comprises means for decrementing the control value, wherein the control value represents the quantity of separate items
- wherein the inventory item attributes further comprise:
  - a control value unit field set to 'days', and
  - an inventory date representing the date when the inventory item entered inventory
- wherein means for detecting changes comprises:
  - means for reading from a clock the current date, and
  - means for calculating the age of the inventory item in dependence upon the current date and the inventory date
- wherein means for recording detected changes comprises means for storing the age of the inventory item in the control value
- wherein means for taking action comprises means for emailing an order to a vendor to reorder the inventory item when the control value is outside the acceptable control value range
- wherein means for taking action comprises means for emailing a message to a user advising the user to discard the inventory item when the control value is outside the acceptable control value range
- wherein means for taking action comprises means for sending, through HTTP and through a vendor service gateway directly to a vendor's online



order system, an HTML order for the inventory item when the control value is outside the acceptable control value range

As mentioned above, the Final Office Action at numbered paragraph 13, regarding Reber, states:

Claims 11-20 are rejected under 35 U.S.C. §102(e) as being anticipated by Reber et. al. (U.S. 5,798,694)(“Reber”). Reber discloses means for providing inventory item attributes comprising data attributes wherein the inventory item attributes describe an inventory item (the tag must have attributes to separate it from other tags; RFID identification tag 30 and code field (inherent), the RFID tag detects changes, records changes, compares control values with acceptable values, and takes action if those actions are outside a range...

In response, Applicants note that the Final Office Action only states that Reber discloses the following claim limitations:

- means for providing inventory item attributes
- wherein the inventory item attributes describe an inventory item
- an RFID identification tag
- RFID identification tag code field
- the RFID tag detects changes
- records changes
- compares control values with acceptable values

- takes action if those actions are outside a range

That is, the Final Office Action only appears to direct Reber to claim 11 of the present application. The Final Office Action, however, makes no mention whatsoever of any of the following limitations and elements as required by the Federal Circuit in *Verdegaal Bros.*:

- ... comprising data elements in computer memory, ..., the inventory item has an ... having an RFID identification tag code, and the inventory item attributes comprise:
  - ...
  - a control value,
  - an acceptable control value range, and
  - an out of range action
- means for ... in the inventory item attributes, wherein means for detecting changes in inventory item attributes include means for reading, through an RFID reader, the RFID identification code from the ... associated with the inventory item
- means for ... detected ... in inventory item attributes
- means for ... and ... control ... range
- means for ...
- wherein the means for detecting changes, means for recording detected changes, means for comparing the control value and the acceptable control value range, and means for taking action are carried out through Java

servlets in at least one OSGI-compliant service bundle installed and operating in an OSGI-compliant service gateway

- wherein the inventory item attributes further comprise a control value unit field set to 'pounds'
- wherein means for detecting changes includes means for reading the weight of the inventory item from a scale
- wherein means for recording detected changes comprises means for storing the weight of the inventory item in the control value
- wherein the inventory item attributes further comprise a control value unit field set to 'freshness'
- wherein means for detecting changes in the inventory attributes of the inventory item further comprises:
  - means for reading from a clock the time when the inventory item is removed from a refrigerator,
  - means for reading the temperature from a kitchen thermometer,
  - means for reading from the clock the time when the inventory item is returned to the refrigerator, and
  - means for calculating a freshness coefficient in dependence upon the time when removed, the time when returned, and the temperature

- wherein means for recording detected changes comprises means for storing the freshness coefficient in the control value
- wherein the inventory item attributes further comprise a control value unit field set to 'utilization'
- wherein means for detecting changes in the inventory attributes of the inventory item includes means for detecting that the inventory item has been removed from and returned to an inventory storage location
- wherein means for recording detected changes comprises means for incrementing the control value, wherein the control value represents the number of times the inventory item has been utilized
- wherein the inventory item comprises a quantity of separate items
- wherein the inventory item attributes further comprise a control value unit field set to 'count'
- wherein means for detecting changes in the inventory attributes includes means for detecting that one of the separate items has been removed from inventory
- wherein means for recording detected changes comprises means for decrementing the control value, wherein the control value represents the quantity of separate items
- wherein the inventory item attributes further comprise:
  - a control value unit field set to 'days', and

- an inventory date representing the date when the inventory item entered inventory
- wherein means for detecting changes comprises:
  - means for reading from a clock the current date, and
  - means for calculating the age of the inventory item in dependence upon the current date and the inventory date
- wherein means for recording detected changes comprises means for storing the age of the inventory item in the control value
- wherein means for taking action comprises means for emailing an order to a vendor to reorder the inventory item when the control value is outside the acceptable control value range
- wherein means for taking action comprises means for emailing a message to a user advising the user to discard the inventory item when the control value is outside the acceptable control value range
- wherein means for taking action comprises means for sending, through HTTP and through a vendor service gateway directly to a vendor's online order system, an HTML order for the inventory item when the control value is outside the acceptable control value range

Though the Final Office Action rejects claims 11-20 as anticipated by Reber, the Final Office Action only cites a few phrases from claim 11 of the present application to support the rejection under 35 U.S.C. § 102(e). The remaining elements and limitations of claim 11 are not even mentioned. In addition, the Final Office Action does not mention any of the additional elements claimed in dependent claims 12-20 as being anticipated by Reber.

Because the Final Office Action does not mention all of the elements and limitations of claims 11-20, the rejections under 35 U.S.C. § 102(e) should be withdrawn, and claims 11-20 should be allowed.

**Examination Of Reber Confirms That Reber Does Not  
Anticipate Each And Every Element As Set Forth In The  
Applicants' Claims**

In the absence of any indication of where in Reber the Examiner believes elements of Applicants' claims to be disclosed, Applicants are under no obligation to comment further regarding the rejections of claims under 35 U.S.C. §102. Nevertheless, in an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants undertake to make their best guess regarding the meaning of the Final Office Action and respond below as best they can under the circumstances.

To anticipate claims 11-20 under 35 U.S.C. § 102(b), two basic requirements must be met. As stated in *Verdegaal Bros. v. Union Oil Co. of California*, the first requirement of anticipation is that Reber must disclose each and every element as set forth in Applicants' claims. *Verdegaal Bros.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The second requirement of anticipation from *In re Hoeksema* is that Reber must enable Applicants' claims. *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). Reber does not meet either requirement and therefore does not anticipate Applicants' claims.

As mentioned above, the Final Office Action at numbered paragraph 13, regarding Reber, states:

Claims 11-20 are rejected under 35 U.S.C. §102(e) as being anticipated by Reber et. al. (U.S. 5,798,694)("Reber"). Reber discloses means for providing inventory item attributes comprising data attributes wherein the

inventory item attributes describe an inventory item (the tag must have attributes to separate it from other tags; RFID identification tag 30 and code field (inherent), the RFID tag detects changes, records changes, compares control values with acceptable values, and takes action if those actions are outside a range...

What Reber in fact discloses is a "Food Storage Apparatus And Methods And Systems For Monitoring A Food Item." Reber, *et al.* (U.S. Patent No. 5,798,694), Title Block (54). The principal purpose of Reber is described in column 10, lines 58-60, stating:

Because the various embodiments of the present invention provide communication of signals between a cover and a container, they provide a significant improvement in that various functions provided by a food storage apparatus can be distributed therein. Additionally, the various embodiments of the present invention as herein-described monitor a condition of a food item to alert an individual of a discard condition of a food item requiring refrigeration.

In fact, the overall message of Reber is that of a food storage apparatus capable of indicating when a food item should be discarded. For further examples of Reber's disclosure and enablement of a food storage apparatus and a method of monitoring a food item, please consider the following excerpts:

- The system includes a food storage apparatus 22 for containing the food item 20 and a storage place 24 for storing the food storage apparatus 22. (column 2, lines 14-18).
- The food storage apparatus 22 includes a container 26 for containing the food item 20. (column 2, lines 19-20).

- Optionally, the food storage apparatus 22 includes a cover 28 to cover the opening of the container 26. (column 2, lines 25-26).
- The container 26 and the cover 28 can be suited for storing and dispensing perishable food items, dry food items, liquid food items, or any combination thereof. (column 2, lines 44-46).
- The food storage apparatus 22 includes an electronic tag 30 ... to monitor at least one condition of the food item 20. (column 3, lines 23-28).
- The indicator 36 can provide an alert or a warning of the condition of the food item 20. (column 3, lines 64-65).
- As with the indicator 36, the indicator 40 can provide either an audible indication or a visual indication of a condition of the food item 20.... (column 4, lines 5-8).
- In a preferred embodiment, the indication is utilized to alert an individual of a condition in which a food item requiring refrigeration should be discarded. (column 4, lines 28-31).

Reber discloses and enables a food storage apparatus and a method of monitoring a food item having little or nothing to do with a system of inventory control as claimed in the present application. As further evidence of the lack of disclosure and enablement in Reber regarding a system of inventory control as claimed in the present application, please note that not one of the following terms or phrases from claims 11-20 of the present application occurs anywhere in Reber, not even once:

- inventory item attributes
- computer memory
- inventory item



- RFID identification tag
- RFID identification tag code field
- control value
- acceptable control value range
- out of range action
- detecting changes
- RFID reader
- recording
- comparing the control value
- taking action
- Java
- OSGI
- gateway
- pounds
- reading the weight
- weight
- scale
- clock
- thermometer
- freshness coefficient
- utilization
- inventory storage location
- quantity
- separate items
- count
- days
- date
- entered inventory
- calculating the age
- storing the age

- emailing
- order
- vendor
- reorder the inventory item
- advising the user

In these circumstances there is no sound basis for believing that Reber in any way discloses or enables elements of claims 11-20 in the present application. Reber discloses a food storage apparatus and method for monitoring a food item, while the present application claims a system of inventory control. Reber also never once mentions many of the words in Applicants' claims 11-20. The Final Office Action therefore does not establish anticipation under 35 U.S.C. § 102(e) using Reber. The rejection of the claims 11-20 should be withdrawn, and the claims should be allowed.

**The Theory of Inherency Is Not Available As A  
Basis For Rejection Of Claims In The Present Case**

The Final Office Action at numbered paragraph 13, regarding Reber, states:

Reber discloses an RFID inventory system with RFID identification tag code field (inherent)...

That is, the Final Office Action, by parenthetically inserting the term 'inherent' in a description of a claim element, apparently intends to invoke the theory of inherency as a basis for rejection of claim 11 in the present case. Except for this one, cryptic, parenthetical term, 'inherent,' the Final Office Action offers no basis, justification, or explanation of why or how an element of claim 11 may be considered inherently disclosed in prior art. In the complete absence of any support in the Final Office Action for the use of inherency, Applicants are under no obligation to comment further. In an effort to move the case forward and without prejudice to their request that the rejections

should be withdrawn, however, Applicants nevertheless undertake to make their best guess regarding the meaning of the Final Office Action.

Applicants therefore assume that the Final Office Action intends to invoke the theory of inherency as a basis for anticipation of the “RFID identification tag code field” element of claim 11 in the present application. The Final Office Action apparently takes the position in effect that some disclosure in Reber necessarily results in the claim element recited above of a RFID inventory system with RFID identification tag code field. The rejection, however, is not accompanied by the required analysis to support a rejection relying on inherency. Merely reciting the word “inherent” is insufficient basis for a rejection on the theory of inherency. In *Ex parte Levy*, the Board of Patent Appeals and Interferences states, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Manual of Patent Examination and Procedure* § 2112 (quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). The Final Office Action does not demonstrate in any way that anything in Reber necessarily results in a RFID inventory system with RFID identification tag code field. In fact, such inherency does not exist. A RFID inventory system with RFID identification tag code field cannot properly be said to necessarily flow from any of the teaching in Reber within the meaning of *Levy*. For this reason alone, Reber can be seen to not disclose or teach the claim element asserted on its behalf. Claim 11 therefore is patentable and should be allowed. Dependent claims 12-20 depend from independent claim 11. Because these dependent claims include each and every limitation of the independent claim from which they depend, these dependent claims stand because their independent claim stands. Claims 11-20 therefore are patentable and should be allowed.

#### **Conclusion Regarding 35 U.S.C. § 102(b)**

In rejecting claims 11-20 under 35 U.S.C. § 102(b) as being anticipated by Reber, the Final Office Action does not satisfy the legal requirements for rejections under 35 U.S.C.

§ 102(e). The Final Office Action fails to provide Applicants with information sufficient to judge the propriety of continuing prosecution as required by 35 U.S.C. § 132 and therefore relieves Applicants of any duty to respond to the rejection. In a best effort to be fully responsive, however, Applicants explained above that the Final Office Action has not established anticipation by Reber because the Final Office Action does not even mention many of the elements of the Applicants' claims. Even examining Reber itself confirms that Reber does not anticipate each and every element of the Applicants' claims, expressly or inherently. Applicants therefore traverse the rejection to each of claims 11-20 in the present application. The rejections of all claims 11-20 under 35 U.S.C. § 102, therefore, should be withdrawn, and the claims should be allowed.

**REJECTIONS OF CLAIMS FOR OBVIOUSNESS UNDER  
35 U.S.C. § 103 AS UNPATENTABLE OVER  
REBER IN VIEW OF PRIOR ART ARE IMPROPER**

Claims 11-20 stand rejected under 35 U.S.C § 103(a) as unpatentable over Reber in view of prior art that "would have been obvious to a person having ordinary skill in the art at the time the invention was made...." Applicants understand the Examiner's reference to 'ordinary skill' to be a reference to 'Well Known Prior Art.' Applicants respectfully submit in response that the Final Office Action fails to provide the Applicants with information sufficient to judge the propriety of continuing prosecution. In addition, Applicants note that the Final Office Action cannot rely on Well Known Prior Art to support the obviousness rejection. Applicants also note in response that the Final Office Action does not establish a prima facie case for obviousness. The proposed combination of Reber and Well Known Prior Art cited does not teach each and every element of the claims of the present application; there is no suggestion or motivation to combine Reber and Well Known Prior Art cited; and there is no reasonable expectation of success in the proposed modification. For all these reasons, the rejections should be withdrawn and the claims should be allowed.

**The Final Office Action Fails To Provide The Applicants With  
Information Sufficient To Judge The Propriety Of  
Continuing Prosecution As Required By 35 U.S.C. § 132**

As noted above, 35 U.S.C. § 132 requires the Examiner to notify the applicants of the reasons for a rejection, including “such information and references as may be useful in judging of the propriety of continuing the prosecution....” 37 C.F.R. § 1.104(c)(2) second sentence requires, “When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.” MPEP § 707 requires, when needed for compliance with 35 U.S.C. § 132, the inclusion in the Final Office Action of “...the particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s)....” MPEP § 707.07(d) warns against omnibus rejections as, “...stereotyped and usually not informative and should therefore be avoided.”

As mentioned above, the reference to Reber in the Final Office Action makes no mention of where in Reber the information relied on by the Examiner may be found. Regarding Well Known Prior Art, the Final Office Action at paragraphs 41 and 42 generally states:

...the Examiner finds that Nathan J. Muller’s Desktop Encyclopedia of the Internet, (“Desktop Encyclopedia”) is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art.

...the Examiner finds that the Borland’s Paradox for Windows User’s Guide is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art.

The Final Office Action, however, makes no mention of where in such Well Known Prior Art references the information relied on by the Examiner may be found.

The only Well Known Prior Art reference cited by the Examiner with any specificity that would be useful in judging of the propriety of continuing the prosecution is Friedman, *et al.* (U.S. Patent 6,593,845) ('Friedman'). The Final Office Action at paragraph 16 states:

It is the Examiner's position that 'out-of-range' indicators in RF tag devices is old and well known in the art. Evidence to support this includes but is not limited to Friedman *et al.* (U.S. 6,593,845 B1) column 5, lines 64-67.

Friedman at column 5, lines 64-67, however, states:

the main tag circuitry 48 can provide the field-off signal if the RF field at the antenna 16 drops below the threshold for a certain period of time, such as indicating that the interrogator has moved out of range.

Friedman's RF tag having an 'out-of-range' indicator provides a signal when a device, referred to in Friedman as an 'interrogator,' travels out of range from the RF tag. The system of inventory control as claimed in the present application does not claim an RF tag having an 'out-of-range' indicator that provides a signal when an interrogator travels out of range from the RF tag. Friedman's RF tag having an 'out-of-range' indicator therefore is not a system for inventory control as claimed in the present application. The Final Office Action's reference to Friedman therefore does not establish that the Well Known Prior Art teaches Applicants' claims.

Because Friedman as cited in the Final Office Action has nothing to do with Applicant's claims, the Final Office Action remains completely silent regarding the location of the information relied on by the Examiner as to claims 11-20 other than generally citing Reber and the Well Known Prior Art composed of the Desktop Encyclopedia of the Internet and the Paradox for Windows User's Guide. Both Reber and the Well Known Prior Art are complex references containing information regarding many technical

subjects and other inventions. In light of the requirements of 35 U.S.C. § 132, it is important for the Examiner to provide some indication of where in Reber and Well Known Prior Art the Examiner believes elements of Applicants' claims to be disclosed or suggested in order for Applicants to have enough information to judge how or whether to continue the prosecution of the present application. Moreover, in the absence of any indication of where within Reber and the Well Known Prior Art the Examiner believes elements of Applicants' claims to be disclosed or suggested, Applicants cannot understand the reasons for the rejections.

For these reasons alone, the rejection of the claims 11-20 should be withdrawn, and the claims should be allowed. Nevertheless, in an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants undertake to make their best guess regarding the meaning of the Final Office Action and respond below as best they can under the circumstances.

**The Final Office Action Cannot Rely On Well Known  
Prior Art To Support The Obviousness Rejection**

In the absence of any indication of where in Reber and Well Known Prior Art the Examiner believes elements of Applicants' claims to be disclosed, Applicants are under no obligation to comment further regarding the rejections of claims under 35 U.S.C. §103. Nevertheless, in an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants undertake to make their best guess regarding the meaning of the Final Office Action and respond below as best they can under the circumstances.

In rejecting claims 11-20 for obviousness under 35 U.S.C. § 103, the Final Office Action at numbered paragraph 15 states:

...it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Reber to expressly indicate an

RFID identification tag code field. Such a modification would have made it clear that RFID tags require unique ID numbers in order to properly identify the tag.

As stated above, the ‘ordinary skill’ so described is taken in this Response as ‘Well Known Prior Art.’ Applicants understand, based on this language from the Final Office Action, that this rejection, based on ‘ordinary skill’ so described, is a rejection relying on common knowledge or Well Known Prior Art according to MPEP 2144.03. Applicants respectfully propose, however, that “to modify Reber to expressly indicate an RFID identification tag code field” is not available to the Examiner in this case as Well Known Prior Art.

According to MPEP § 2144.03, the Examiner may use as Well Known Prior Art facts outside the record only if such facts are capable of instant and unquestionable demonstration as being well-known in the art. Well Known Prior Art, however, may not be substituted for facts which cannot be instantly and unquestionably demonstrated. As indicated in *In re Lee*, the examiner’s finding of whether there is a teaching, motivation or suggestion to combine the teachings of the applied reference must not be resolved based on “subjective belief and unknown authority,” but must be “based on objective evidence of record.” *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). The court in *Lee* requires evidence for the determination of unpatentability by clarifying that “common knowledge and common sense,” as mentioned in *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969), may only be applied to analysis of the evidence, rather than be a substitute for evidence. *In re Lee*, 277 F.3d at 1345, 61 USPQ2D at 1435.

In this case, Applicants note with respect that the Examiner has made a mere naked assertion that a fact is well known in the prior art with absolutely no “objective evidence of record” and no expression of any reason why one having ordinary skill in the pertinent art would have been led to modify the prior art to arrive at the claimed invention. As mentioned, Well Known Prior Art may not be substituted for facts which cannot be



instantly and unquestionably demonstrated. The assertion in the Final Office Action that “it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Reber to expressly indicate an RFID identification tag code field” cannot be instantly and unquestionably demonstrated. For these reasons, the Final Office Action cannot rely on the assertion that such a modification is taught in the Well Known Prior Art to support the obviousness rejection. This rejection therefore fails to establish a prima facie case of obviousness. Claims 11-20 are patentable and should be allowed.

**Reber and Well Known Prior Art Do Not Establish  
A Prima Facie Case For Obviousness**

In the absence of any indication of where in Reber and Well Known Prior Art the Examiner believes elements of Applicants’ claims to be disclosed, Applicants are under no obligation to comment further regarding the rejections of claims under 35 U.S.C. §103. Nevertheless, in an effort to move the case forward and without prejudice to their request that the rejections should be withdrawn, Applicants undertake to make their best guess regarding the meaning of the Final Office Action and respond below as best they can under the circumstances.

To establish a prima facie case of obviousness, three basic criteria must be met in accordance with MPEP § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants’ claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

**The Combination Of Reber and Well Known Prior Art  
Does Not Teach All Of Applicants' Claim Limitation**

To establish a prima facie case of obviousness under 35 U.S.C. § 103, the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). In rejecting claims 11-20 under 35 U.S.C. § 103, the Final Office Action relies exclusively on Reber for disclosure or suggestion of several of the elements of claim 11. Final Office Action at numbered paragraph 15. As shown above, Reber does not disclose those elements relied on by the Final Office Action. The combination of Reber and Well Known Prior Art therefore cannot teach or suggest all of the Applicants' claim limitations. For these reasons, the proposed combination of Reber and Well Known Prior Art does not establish a prima facie case of obviousness. Dependent claims 12-20 depend from independent claim 11. These dependent claims include each and every limitation of the independent claim from which they depend. These dependent claims stand because independent claim 11 stands. The rejections of all claims 11-20 under 35 U.S.C. § 103, therefore, should be withdrawn. Applicants respectfully traverse the rejection to each of claims 11-20 and request claims 11-20 be allowed.

**No Suggestion or Motivation to Combine Reber  
and The Well Known Prior Art**

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Reber. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify Reber must come from the teaching of the cited art itself, and the Examiner must explicitly point to the teaching within the cited art suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18

U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

In this case, the Final Office Action makes no mention whatsoever of any evidence of suggestion or motivation to modify Reber, neither in Reber itself nor in Well Known Prior Art. Because the Final Office Action does not explicitly point a teaching within the cited art that suggests or motivates the combination of Reber and Well Known Prior Art, the Final Office Action does not establish a prima facie case of obviousness. For this reason, the rejection of claims 11-20 should be withdrawn, and claims 11-20 should be allowed.

**No Reasonable Expectation of Success in the  
Proposed Combination of Reber and Well Known Prior Art**

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Reber. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). In this case, the Final Office Action makes no mention whatsoever of any evidence that a reasonable expectation of success in a proposed combination of Reber's disclosure of a food storage apparatus and a method of monitoring a food item with the "RFID identification tag code field" from Well Known Prior Art to produce claim 11 of the present application. As such, no proposed modification of Reber can establish a prima facie case of obviousness. For this reason, the rejection of claim 11 should be withdrawn, and claim 11 and all claims 12-20 depending from it should be allowed.

**Conclusion Regarding 35 U.S.C § 103(a)**

In rejecting claims 11-20 as unpatentable over Reber in view of prior art that "would have been obvious to a person having ordinary skill in the art at the time the invention was made...", the Final Office Action does not satisfy the legal requirements for a

rejection under 35 U.S.C § 103(a). As explained above, the Final Office Action fails to provide the Applicants with information sufficient to judge the propriety of continuing prosecution. In addition, the Final Office Action cannot rely on Well Known Prior Art to support the obviousness rejection. The Final Office Action also does not establish a prima facie case for obviousness because the proposed combination of Reber and Well Known Prior Art does not teach each and every element of the claims of the present application, there is no suggestion or motivation to combine Reber and Well Known Prior Art cited, and there is no reasonable expectation of success in the proposed modification. For all these reasons, the rejections of claims 11-20 should be withdrawn and the claims should be allowed. Claims 1-10 and 21-30 claim method and computer program product aspects respectively of the systems claimed in claims 11-20, a relationship acknowledged in the Final Office Action at numbered paragraph 17. Because claims 11-20 stand, claims 1-10 and 21-30 also stand. Applicants therefore respectfully traverse each rejection individually of claims 1-30 in the present application because these claims are patentable and should be allowed.

### **LEXICOGRAPHY OF THE SPECIFICATION**

The Final Office Action in numbered paragraph 18 states:

Examiner concludes that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings.

To support the Examiner's conclusion, the Final Office Action at paragraph 18 states that "the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s)." That is, the Examiner implies that the Applicants have chosen not to define any terms in the specification because the Examiner cannot locate any lexicographic definition. Applicants note in response that the specification includes fifty pages that include eleven drawings and a section of definitions. Applicants point out that the section of definitions begins on page 8 of the

specification. In addition, Applicants note that, in addition to the section particularly devoted to definitions as such, various terms are defined also throughout the specification. Because Applicants have provided a section of definitions and various terms are defined throughout the specification, the implicit assertion in the Final Office Action that Applicants have chosen not to define any terms in the specification is incorrect. Applicants therefore respectfully submit that there is no support for the Examiner's conclusion that Applicants have decided not to be their own lexicographer.

In further support of the Examiner's conclusion that the Applicants have decided not to be their own lexicographer, the Final Office Action at paragraph 18 states:

the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements with the required clarity, deliberateness, and precision.

That is, the Final Office Action asserts that the Applicants' specification does not point to any of the claim terms and define those claim terms with the required clarity, deliberateness, and precision. This is simply and obviously untrue in view of the briefest and most casual glance at the present patent application. The present application is simply filled with definitions and explanations of claim terms, fifty pages including eleven drawings in which the claim, the claim elements, and all claim limitations are explained and defined in complete and absolutely perfect detail. Out of the dozens of terms so defined and explained, Applicants present for explanation two examples of such definitions and explanations, one for the claim term 'RFID' and one for the claim term 'OSGI.' The claim term 'RFID' appears in claim 1 as follows:

1. A method of inventory control comprising the steps of:  
providing inventory item attributes comprising data elements in computer memory, wherein the inventory item attributes describe an inventory item,

the inventory item has an RFID identification tag having an RFID identification tag code, and the inventory item attributes comprise:

- an RFID identification tag code field,
- a control value,
- an acceptable control value range, and
- an out of range action;

detecting changes in the inventory item attributes, wherein detecting changes in inventory item attributes includes reading, through an RFID reader, the RFID identification code from the RFID tag associated with the inventory item;

recording detected changes in inventory item attributes;

comparing the control value and the acceptable control value range; and

taking action in dependence upon the result of the comparing and the out of range action.

The claim term ‘RFID’ is defined and explained on page 10 of the original application as follows:

“RFID” means Radio Frequency Identification, a technology for identifying objects by use of an antenna, a transceiver, and a transponder. RFID transceivers, in this specification, are referred to as “RFID readers.” As the term ‘transceiver’ implies, however, RFID readers both read and write information to and from RFID transponders. RFID transponders are referred to in this specification as “RFID tags.” RFID tags are programmed with RFID identification codes unique to each RFID tag. In addition, RFID tags are programmed in some embodiments with other information in addition to RFID identification codes, such as, for example, inventory item type codes, location codes, inventory dates, control values, and so on.

The claim term ‘OSGI’ occurs in claim 2 as:

2. The method of claim 1 wherein the steps of detecting changes, recording detected changes, comparing the control value and the acceptable control value range, and taking action are carried out through Java servlets in at least one OSGI-compliant service bundle installed and operating in an OSGI-compliant service gateway.

The claim term ‘OSGI’ is defined and explained on page 12 of the original application as:

“OSGI” refers to the Open Services Gateway Initiative, an industry organization developing specifications for service gateways, including specifications for delivery of service bundles, software middleware providing compliant data communications and services through service gateways. The Open Services Gateway specification is a java based application layer framework that gives service providers, network operator device makers, and appliance manufacturer’s vendor neutral application and device layer APIs and functions. An “API” is an Application Program Interface, a set of routines, protocols, and tools for building software applications.

The most casual glance at the present application immediately dispels any notion whatsoever that Applicants may have failed in any way to explain claim terms with reasonable clarity, deliberateness, or precision. Because Applicants’ specification points to various claim terms and provides definitions for those claim terms with clarity, deliberateness, and precision, Applicants respectfully submit that there is no possible support for the Examiner’s conclusion that Applicants have decided not to be their own lexicographer.

Still further in support of the Examiner’s conclusion that the Applicants have decided not to be their own lexicographer, the Final Office Action at paragraph 18 states:

after receiving express notice in the previous Office Action of the Examiner’s position that lexicography is not invoked, Applicants have not

pointed out the “supposed errors” in the Examiner’s position regarding lexicography invocation in accordance with 37 C.F.R. § 1.111(b) (*i.e.* Applicants have not argued lexicography is invoked).

That is, the Final Office Action asserts that Applicants have decided not to be their own lexicographer because the Applicants’ did not point out supposed errors in the Examiners’ position regarding lexicography in Applicants’ Response to the Office Action dated February 3, 2005 (‘First Office Action’) in accordance with 37 C.F.R. § 1.111(b). Applicants’ comments regarding lexicography in Applicants’ Response to the First Office Action, however, does comport with 37 C.F.R. § 1.111(b). 37 C.F.R. § 1.111(b) states, “The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner’s action....” The First Office Action at page 7 states that “the Examiner is unaware of any desire—either expressly or implicitly—by Applicants to be their own lexicographer and to define a claim term to have a meaning other than its ordinary and accustomed meaning.” In Applicants’ Response to the First Office Action, however, Applicants provided an entire section entitled “Lexicography of the Specification” distinctly and specifically pointing out the error in the assertion of the First Office Action that the Applicants had no desire to be their own lexicographer. In the Response to the First Office Action, Applicants pointed out that the Applicants provided a specification of 50 pages that includes eleven drawings and *a section of definitions* to aid the Examiner in interpreting the claims. Applicants further noted that where an explicit definition is provided by the Applicants for a term, that definition will control interpretation of the term as it is used in the claim. By informing the Examiner that “a section of definitions” existed in the specification and that those definitions control interpretation of the claims, Applicants distinctly and specifically pointed out the supposed errors in the First Office Action in accordance with 37 C.F.R. § 1.111(b). Because the Applicants distinctly and specifically pointed out the supposed errors in the First Office Action, Applicants respectfully submit that there is no support for the Examiner’s conclusion that Applicants have decided not to be their own lexicographer.



In support of the Examiner's conclusion that the Applicants have decided not to be their own lexicographer, the Final Office Action at paragraph 18 states:

the Examiner also notes that Applicants have declined the Examiner's express invitation to be their own lexicographer.

Applicants note in response that lexicography is the Applicants right under 35 U.S.C. § 112, second paragraph, not a privilege granted to the Applicants through an Examiner's invitation. Manual of Patent Examining Procedure § 2173.01 states:

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification.

As noted above, Applicants' specification provides a section of definition that begins on page 8. In addition, Applicants clearly define various terms throughout the specification such as, for example, 'OSGI' on page 12 of the specification. Applicants therefore became their own lexicographer under 35 U.S.C. 112, second paragraph, when the Applicants filed the present application on January 31, 2002. The Applicants therefore did not need to accept or reject the Examiner's invitation to be their own lexicographer. Because Applicants clearly set forth Applicants' intent regarding lexicography when the present application was filed, Applicants respectfully submit that there is no support for the Examiner's conclusion that Applicants have decided not to be their own lexicographer.

#### **SUBJECT MATTER OF CLAIMS 11-30**

The Final Office Action at numbered paragraph 20 states:

The Examiner maintains his position that claims 11-30 are product or machine claims.

Applicants respectfully note in response that claims 11-20 are directed to a system patentable under 35 U.S.C. § 101. Applicants also note with respect that the computer program products claimed in claims 21-30 are directed to patentable articles of manufacture within the meaning of 35 U.S.C. § 101.

**APPLICANTS' RESPONSE TO EXAMINER'S RESPONSE  
TO APPLICANTS' RESPONSE TO THE FIRST OFFICE  
ACTION DATED FEBRUARY 3, 2005**

The Final Office Action responds to Applicants' Response to First Office Action of February 3, 2005 ('First Office Action') with various arguments as explained below. Applicants traverse the responses provided in the Final Office Action to Applicants' Response to the First Office Action for the reasons discussed below.

**Applicants Are In Compliance With MPEP § 2181**

In response to the Applicants' Response to First Office Action, the Final Office Action at paragraph 22 states:

The Examiner maintains his objections to the specification. Applicants arguments are not persuasive because MPEP § 2181 expressly indicates the procedure for Applicants to follow regarding these objections.

Applicants' legal obligation regarding enablement of means claims is set forth in MPEP § 2181 which states, "37 CFR 1.75(d)(1) provides, in part, that 'the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.'" *Manual of Patenting Examination Procedure* § 2181 IV. As discussed in detail above in

the section entitled ‘The Objection to the Specification Is Improper,’ the means claims in the present application are well enabled in the specification because Applicants have provided clear support or antecedent basis for the means claims in compliance with 37 CFR § 1.75. The Applicants therefore maintain their traversal of the objection to the specification, and respectfully request the withdrawal of the objection.

**Applicants Have Made A Reasonable Attempt At Addressing  
The Rejections Under 35 U.S.C. § 112, Second Paragraph**

In response to the Applicants’ Response to First Office Action, the Final Office Action at paragraph 23 states:

The Examiner maintains his position on the 35 U.S.C. § 112, 2<sup>nd</sup> paragraph rejections. In particular, the reason for the Examiner states that the claims are replete with errors is because it is quite clear that the claims contain at least three (3) 35 U.S.C. § 112, 2<sup>nd</sup> paragraph errors. Applicants have not made a reasonable attempt at addressing these errors.

Applicants note in response that the claims do not contain “at least three (3) 35 U.S.C. § 112, 2<sup>nd</sup> paragraph errors” for the reason discussed above in the section of this Brief entitled ‘Rejections For Claims 1-30 Under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph, Are Improper’ and in the section entitled ‘Claim Rejections – 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph’ in Applicants’ Response to the First Office Action. In those sections, Applicants specifically pointed to references in the specification relating to the three means claims cited in the First Office Action and fulfilled Applicants’ obligation under MPEP § 2181. MPEP § 2181 states that in determining whether a means-plus-function has support in the written description, “[t]he proper test for meeting the definiteness requirement is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function. See *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381, 53 USPQ2d

1225, 1230 (Fed. Cir. 1999).” In view of the sections mentioned above that cite the detailed descriptions in the specification relating to the means claims mentioned in the First Office Action, it is clear that Applicants have made a reasonable attempt at addressing the objection to the specification made in the First Office Action. The Applicants therefore maintain their traversal of the rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, and respectfully request the withdrawal of the rejections.

**The Examiner’s Requirement That The Applicants Must Point Out The  
Corresponding Structure Of All Phrases That Potentially Invoke 35 U.S.C. § 112,  
Sixth Paragraph, Is Unfounded**

In response to the Applicants’ Response to First Office Action, the Final Office Action at paragraph 24 states:

Regarding the 35 U.S.C. § 112, 2<sup>nd</sup> paragraph and its relation to 35 U.S.C. § 112, 6<sup>th</sup> paragraph, it is the Examiner’s factual determination that it would not be unreasonable for applicants to assume that Applicant must point out the corresponding structure in all phrases that potentially invoke 35 U.S.C. § 112, 6<sup>th</sup> paragraph.

In support of such an assertion that Applicants must point out the corresponding structure in all phrases that potentially invoke 35 U.S.C. § 112, sixth paragraph, the Final Office Action cites *Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 68 USPQ2d 1263, 1268 (Fed. Cir. 2003). *Medical Instrumentation and Diagnostics Corp.* as cited in the Final Office Action, however, does not support the assertion of the Final Office Action that Applicants must point out the corresponding structure in all phrases that potentially invoke 35 U.S.C. § 112, sixth paragraph. The portion of *Medical Instrumentation and Diagnostics Corp.* cited in the Final Office Action instead states:

The duty of a patentee to clearly link or associate structure with the claimed function is the quid pro quo for allowing the patentee to express

the claim in terms of function under section 112, paragraph 6. Section 112, paragraph 6 was intended to allow the use of means expressions in patent claims without requiring the patentee to recite in the claims all possible structures that could be used as means in the claimed apparatus. However, the price that must be paid for use of that convenience is limitation of the claim to the means specified in the written description and equivalents thereof. If the specification is not clear as to the structure that the patentee intends to correspond to the claimed function, then the patentee has not paid that price but is rather attempting to claim in functional terms unbounded by any reference to structure in the specification. Such is impermissible under the statute.

That is, *Medical Instrumentation and Diagnostics Corp.* in the cited portion of the Final Office Action only stands for the proposition that the Applicants must clearly link or associate structure with the claimed means functions of the present application. As discussed above, Applicants have already clearly linked or associated structure with the claimed means functions of the present application in the section of this Brief entitled ‘Rejections For Claims 1-30 Under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph, Are Improper’ and in the section entitled ‘Claim Rejections – 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph’ in Applicants’ Response to the First Office Action.

Because the cited portion of *Medical Instrumentation and Diagnostics Corp.* does not support the assertion of the Final Office Action, the Examiner’s requirement that the Applicants point out the corresponding structure of all phrases that potentially invoke 35 U.S.C. § 112, Sixth Paragraph, is unfounded. Moreover, no such requirement could possibly exist because, under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 72 F.3d 857 (Fed. Cir. 1995), and its progeny, such a requirement would effectively write structure into the claims, and, according to *Medical Instrumentation and Diagnostics Corp.*, applicants are *not* required by 35 U.S.C. § 112 subparagraph 6 to include structure in means claims. The Applicants therefore maintain their traversal of the rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, and respectfully request the

withdrawal of the rejections.

### **The Term ‘OSGI’ Is Not Indefinite**

In response to the Applicants’ Response to First Office Action, the Final Office Action at paragraph 25 states:

Regarding the term “OSGI,” the Examiner maintains his position that the term is indefinite. It is the Examiner’s position that OSGI is indefinite on its face because looking at the claim alone, one of ordinary skill in the art can not reasonably understand what is meant by OSGI.

In support of the assertion that the term ‘OSGI’ is indefinite, the Final Office Action quotes *In re Wiggins*, 488 F.2d 538, 179 USPQ 421, 423 (CCPA 1973) as follows: “If the scope of the invention sought to be patented is unclear from the language of the claim, a second paragraph rejection will properly lie.” Applicants note with respect, however, that nothing in *In re Wiggins* suggest that the language of the claims is not interpreted in light of the specification. In fact, the Court in *In re Wiggins* states the opposite:

Words in claims are to be given “their broadest reasonable interpretation consistent with the specification where the patent has not yet issued and the applicant has an opportunity to change them.” *In re Finsterwalder*, 58 CCPA 871, 876, 436 F.2d 1028, 1032, 168 USPQ 530, 534 (1971).

*In re Wiggins*, 488 F.2d 538, 542, 179 USPQ 421. As discussed above, the *Manual of Patent Examining Procedure* also recognizes the rule that claims are interpreted in light of the specification. MPEP § 2173.02 states:

Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The

teaching of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.”

For all the reasons set forth in the above section of this Brief entitled ‘Rejections For Claims 1-30 Under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph, Are Improper’ and in the section entitled ‘Claim Rejections – 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph’ in Applicants’ Response to the First Office Action, Applicants note that the term ‘OSGI’ is sufficiently definite as required by 35 U.S.C. § 112, second paragraph, when analyzed in light of the content of the Applicants’ disclosure. Because the term ‘OSGI’ is not indefinite as asserted in the Final Office Action, the Applicants maintain their traversal of the rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph and respectfully request the withdrawal of the rejections.

**The Examiner Is Bound By The Holding In *Verdegaal Bros. v. Union Oil Co. of California* In Determining Whether Applicants’ Claims Are Anticipated By Reber**

In Applicants’ Response to the First Office Action, Applicants asserted that Applicants’ claims are anticipated by Reber only if each and every element as set forth in the claim is found, either expressly or inherently described, in Reber. In support of such an assertion, Applicants cited *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In response to the Applicants’ Response to First Office Action that Applicants’ claim are not anticipated by Reber, the Final Office Action at paragraph 26 states:

Regarding Applicants’ discussion of *Verdegall Bros. v. Union Oil* [sic], the Examiner notes that *Verdegall Bros.* [sic] was an inter partes infringement case. This is ex parte examination. It is the Examiner’s position therefore that *Verdegall Bros.* [sic] is not necessarily controlling.

That is, the Examiner takes the position that because *Verdegaal Bros. v. Union Oil Co. of California* is an inter partes infringement case, the holding of *Verdegaal Bros.* regarding

anticipation of Applicants' claims does not apply in the present application. In response, Applicants note that the Examiner is bound by the *Manual of Patent Examining Procedure* regarding prosecution of Applicants' claims in the present case. The Forward of the *Manual of Patent Examining Procedure* states:

This Manual is published to provide U.S. Patent and Trademark Office (USPTO) patent examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of patent applications before the USPTO. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application.

*Manual of Patent Examining Procedure* § 2131 guides the Examiner in applying 35 U.S.C. § 102(e) to reject Applicants' claims as anticipated by Reber. In fact, the title of MPEP § 2131 is "Anticipation — Application of 35 U.S.C. 102(a), (b), and (e)." Under the heading entitled "To Anticipate A Claim, The Reference Must Teach Every Element Of The Claim," MPEP § 2131 states:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Because MPEP § 2131 incorporates this holding of *Verdegaal Bros. v. Union Oil Co. of California* and the Examiner is bound to follow the guidelines for patent prosecution as set forth in the *Manual of Patent Examining Procedure*, the Examiner is bound by the holding in *Verdegaal Bros. v. Union Oil Co. of California* in determining whether Applicants' claims are anticipated by Reber. As discussed above, the Final Office Action does not demonstrate that Reber discloses each and every element as set forth in



Applicants' claims. Applicants therefore maintain their traversal of the rejections under 35 U.S.C. § 102 and respectfully request the withdrawal of the rejections.

**Applicants' Claims Are Not Indefinite**

In response to the Applicants' Response to First Office Action, the Final Office Action at paragraph 27 states:

Because the claims are indefinite, they can not be construed. See Paragraph No. 11, supra. It is therefore impossible to tell whether the "means for" phrases are present in the reference.

Applicants note in response that the claims of the present application are not indefinite for the reason discussed above in the section of this Brief entitle "Rejections For Claims 1-30 Under 35 U.S.C. § 112, 2<sup>nd</sup> Paragraph, Are Improper." Because Applicants' claims are not indefinite, Applicants maintain their traversal of the rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, and respectfully request the withdrawal of the rejections.

**Applicants Are Not Required To Present Clear And Convincing  
Evidence That Reber Is Not Enabled**

In response to the Applicants' Response to First Office Action, the Final Office Action at paragraph 28 states:

Regarding Applicants' enablement arguments, they too are not persuasive because Applicants have not presented clear and convincing evidence that Reber is not enabled.

That is, the Final Office Action implies that Applicants have the burden to rebut a presumption that Reber is an enabling disclosure by presenting clear and convincing evidence that Reber is not an enabling disclosure. Applicants assume that the Final

Office Action is attempting to take advantage of the presumption that Reber is an enabling disclosure under MPEP § 2121. MPEP § 2121 states:

When the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980).

In response, Applicants note that Reber does not expressly disclose all of the elements of the Applicants' claims in the present invention for the reasons discussed above in the section of this Brief entitled "Rejections Of Claims 11-20 Under 35 U.S.C. § 102 As Being Anticipated By Reber Are Improper." Because Reber does not expressly disclose all of the elements of the Applicants' claims in the present invention, the Examiner does not have the benefit of a presumption that Reber is an enabling disclosure of anything in the claims of the present application. Applicants therefore do not have the burden to provide facts under any evidentiary standard to rebut the presumption that Reber is an enabling disclosure. Applicants maintain their traversal of the rejections under 35 U.S.C. § 102 and respectfully request the withdrawal of the rejections.

**The Final Office Action Does Not Provide Sufficient Information For Applicants To Respond To The Examiner's Factual Determination That Conventional Non-Volatile Memory Of An RF-Tag Contains At Least Two Sections**

The Final Office Action at paragraph 29 states:

It is Examiner's factual determination that conventional non-volatile memory of an RF-tag contains at least two sections. The first memory contains a unique tag identification number and other data such as, e.g. UPC code and price. The second memory is a 'flag.' Evidence to support this conclusion includes *e.g.* Cofino et. al. (U.S. 5,966,082) column 4,

lines 39-63.

The Final Office Action offers no explanation as to as to why this assertion is included in the Final Office Action. What Cofino actually discloses at column 4, lines 39-63 is:

FIG. 3 is a block diagram of the layout of memory 70 of the tag non-volatile memory section 44. The tag non-volatile memory is laid out as a first tag memory 72 and a second tag memory 74. The first tag memory is the conventional non-volatile memory of an RF tag which contains, for example, a unique tag identifying number, and other data such as a UPC code and a price, for example. The second tag memory 74 is a non-volatile field called an "intention to write to memory" field.

The "intention to write to memory" field 74 may consist of a single bit, which may be called a "flag", or it may comprise more than one bit.

If the "intention to write to memory" field 74 consists of more than one bit, the "intention to write to memory" field could contain information about which field in the first memory 72 was to be written, and in subsequent communication, the base station would know that only a certain field would be suspect. Many ways to write this information are clear to one skilled in the art. The address of a particular field in first memory 72 to be written could be encoded in the "intention to write to memory" field 74 as, for example, a start bit and a length or a start bit and a stop bit, or even a field name if the tag is sufficiently "smart" to recognize field names.

That is, Cofino discloses use of a portion of RF tag memory as an 'intention to write to memory' field. Given this disclosure in Cofino, Applicants do not understand why this assertion regarding Cofino is in the Final Office Action. The Final Office Action provides no explanation as to whether this assertion is related to rejections or objections under 35 U.S.C. § 102, 35 U.S.C. § 103, 35 U.S.C. § 112, or any other area of law. In

Applicants' usual effort to move the case forward despite inadequate notice in the Final Office Action, Applicants would attempt to speculate regarding the reason for the inclusion of this assertion in the Final Office Action. Applicants, however, do not have enough context regarding this assertion to speculate as to why this assertion is included in the Final Office Action. Applicants' claims in the present application simply do not have any relationship to using a portion of RF tag memory as an 'intention to write to memory' field as disclosed in the referenced section of Cofino.

### **The Final Office Action Does Not Properly Establish Inherency**

In response to the Applicants' Response to First Office Action, the Final Office Action at paragraph 30 states:

The Examiner maintains his position on inherency. It is the Examiner's factual determination that the natural flowing result of the functions of tag 30 in Reber discloses a tag code field and attributes. This is reasonable because the tags need to be differentiated. If a tag does not have a tag code field with attributes, the system would be unable to recognize one tag from another. Moreover, because conventional RF tags contain *e.g.* UPC information, they have attributes.

That is, the Final Office Action asserts that "an RFID identification tag code field" and "inventory item attributes" are inherently disclosed in Reber. In response, Applicants note that "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Final Office Action, however, does not provide extrinsic evidence that makes clear that “an RFID identification tag code field” and “inventory item attributes” are necessarily present in Reber’s food storage apparatus and methods and systems for monitoring a food item. Regarding the “an RFID identification tag code field,” the Final Office Action merely asserts: “This is reasonable because the tags need to be differentiated. If a tag does not have a tag code field with attributes, the system would be unable to recognize one tag from another.” The Final Office Action, however, assumes a given set of circumstances where recognizing one tag from another is an objective of the system utilizing the RFID tags. All systems utilizing RFID tags do not, however, have such an objective. Consider, for example, a system that counts each time an item passes by a checkpoint during a given time period using an RFID tag attached to each item. The system is not concerned with differentiating RFID tags; the system is only concerned with counting each time the RFID tag passes by the checkpoint.

Regarding “inventory item attributes,” the Final Office Action merely asserts that “because conventional RF tags contain *e.g.* UPC information, they have attributes.” The Final Office Action, however, assumes a given set of circumstances where an RFID tag contains “*e.g.* UPC information.” Continuing with the example system that counting each time an RFID tag passes by a checkpoint, such a system would have not need to incorporate any attribute information regarding the item passing by the checkpoint. The Final Office Action therefore attempts to establish inherency by the fact that certain RFID tags may contain “an RFID identification tag code field” and “inventory item attributes” based on a given set of circumstances. Because the Final Office Action states that “an RFID identification tag code field” and “inventory item attributes” are inherently disclosed in Reber as a result of a given set of circumstances, the Final Office Action has not properly established inherency. Applicants therefore maintain their traversal of the rejections under 35 U.S.C. § 102 and respectfully request the withdrawal of the rejections.

**Bar Code Tags and RF Tags Are Not Art Recognized Equivalents**

In response to the Applicants' Response to First Office Action, the Final Office Action at paragraph 31 states, "The Examiner maintains his position that bar code tags and RF tags are art recognized equivalents." The Final Office Action provides no additional reasoning or support for the position that bar code tags and RF tags are art recognized equivalents beyond the arguments in the First Office Action. The First Office Action at number paragraph 21 states:

...[I]t is the Examiner's factual determination that bar code tags and radio frequency ("RF") tags are art recognized equivalents. See MPEP §2144.06. Both bar code tags and RF tags are used for the same purpose: conveying information about the article to which the tags are attached to a read machine. Additionally, one of ordinary skill in the art recognizes that the selection of either a bar code tag over an RF tag (or vice versa, RF tag over a bar code tag) is not enough to distinguish a claimed invention over the prior art since both devices are recognized as interchangeable. See MPEP §2144.07.

These statements in the First Office Action amount to a use of Well Known Prior Art as a basis for a finding of obviousness. The First Office Action, however, provides no evidentiary support for this use of Well Known Prior Art. With respect, Applicants submit that the Examiner is not free to use Well Known Prior Art in this manner in the absence of evidence that the fact asserted is capable of instant and unquestionable demonstration as being well-known in the art. Well Known Prior Art may not be substituted for facts which cannot be instantly and unquestionably demonstrated.

In this case, Applicants submit with respect that the Examiner has made a mere naked assertion that bar code tags and RFID tags are recognized equivalents in the prior art with no objective evidence of record. The Final Office Action does not provide any references by which the Applicants may judge the use of such Well Known Prior Art. The First

Office Action merely cites ten different patents without providing Applicant's any references as to any location in those patents of any information on which the Examiners relied in forming a conclusion regarding Well Known Prior Art. In light of the requirements of 35 U.S.C. § 132 explained above, it is essential for the Final Office Action and the First Office Action to provide some indication of where the Examiner finds support in these references for the above conclusions. Without these references, Applicants do not have enough information to judge how to proceed with the prosecution of the present application. Moreover, in the absence of any indication of where within these ten patent references the Examiner believes bar code tags and RF tags are disclosed to be equivalents, Applicants cannot understand the reasons for the rejections.

In addition regarding the equivalence of bar coding and RFID tags, Applicants submit that the ten patents cited in an omnibus fashion by the Examiner in the First Office Action cannot possibly support the conclusion of equivalence in the prior art for bar code tags and RFID tags. Consider Eberhardt (U.S. Patent 5,382,784), for example. Eberhardt describes a hand-held dual technology identification tag reading head, a device for reading both bar code tags and RFID tags. It is important to note, however, that the device disclosed in Eberhardt requires the inclusion of two completely different reading technologies within the device in order to read both bar code tags and RFID tags, a laser reader for bar code tags and a radio frequency reader for RFID tags. The same distinction between bar coding and RFID technology is evident in all of the ten patents cited in the Final Office Action. Scribner (U.S. Patent 4,688,026), for example, beginning at column 1, line 32, affirmatively discusses at some length the functional differences between bar coding and RFID. In view of their completely separate fundamental nature, it is simply not possible that there may be evidence anywhere of the kind of functional equivalence or interchangeability between bar codes and RFID alleged in the Final Office Action in the present case. Applicants therefore maintain their traversal of the rejections under 35 U.S.C. § 103(a) and respectfully request the withdrawal of the rejections.

**The Final Office Action Provides No Evidence To Suggest  
Or Motivate The Modification Of Reber**

In response to the Applicants' Response to First Office Action, the Final Office Action at paragraph 33 states:

Applicants' argument stating that "the Office Action makes no mention whatsoever of any evidence of suggestion or motivation to modify Reber" has been considered but is not persuasive because the Examiner expressly stated in both the First Non Final Office Action and this Office Action that "Such a modification would have make it clear that RFID tags require unique ID numbers in order to properly identify the tag."

Applicants note in response that the assertion by the Examiner in the First Office Action and the Final Office Action that "Such a modification would have made it clear that RFID tags require unique ID numbers in order to properly identify the tag" is a conclusion by the Examiner, not evidence from the cited art itself. The suggestion or motivation to modify Reber must come from the teaching of the cited art itself, and the Examiner must explicitly point to the teaching within the cited art suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.,2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

In this case, the neither the Final Office Action nor the First Office Action mentions any evidence of suggestion or motivation to modify Reber, neither in Reber itself nor in Well Known Prior Art. As such, no proposed modification of Reber can establish a prima facie case of obviousness. Applicants therefore maintain their traversal of the rejections under 35 U.S.C. § 103(a) and respectfully request the withdrawal of the rejections.



**There Is No Reasonable Expectation Of Success In The Proposed  
Combination Of Reber And Well Known Prior Art**

In response to the Applicants' Response to First Office Action, the Final Office Action at paragraph 34 states:

Applicants' argument with respect to 'Expectation of Success' have been considered but are not persuasive because such technology is old and well known. See again *e.g.* Cofino and the other art of record.

In response, Applicants respectfully submit that "because such technology is old and well known" has nothing whatsoever to do with whether there is a reasonable expectation of success in combining Reber and Well Known Prior Art. Reber discloses a food storage apparatus and a method of monitoring a food item. The Final Office Action and the First Office Action make use of Well Known Prior Art to teach "an RFID identification tag code field." The combination of Reber's food storage apparatus and a method of monitoring a food item with an RFID identification tag code field from Well Known Prior Art does not produce the inventory control system claimed in claim 11 of the present application. There cannot therefore be a reasonable expectation of success in the proposed combination of Reber and the Well Known Prior Art. Applicants therefore maintain their traversal of the rejections under 35 U.S.C. § 103(a) and respectfully request the withdrawal of the rejections.

**Neither The First Office Action Nor The Final Office Action  
Demonstrate That Reber Anticipates Applicants' Claims**

In response to the Applicants' Response to First Office Action, the Final Office Action at paragraph 36 states:

Applicants' arguments regarding anticipation have been fully considered

but because those arguments fail to account for or consider the skilled artisan's 'knowledge of the particular art' in *combination* with a reference, such arguments are not persuasive.

That is, the Final Office Action takes the position in effect that the Examiner is entitled to point to one or two elements or limitations of Applicants' claims in a prior art reference and then state that one skilled in the art would have knowledge of the remaining claim elements without providing any evidence regarding the level of skill in the art. As the Commissioner is well aware, however, such is not the law. Applicants respectfully note that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As noted above, both the First Office Action and the Final Office Action assert that Reber explicitly discloses various elements of Applicants' claim and inherently discloses "an RFID identification tag code field." When relying on the theory of inherency to show that Reber discloses "an RFID identification tag code field," the First Office Action and the Final Office Action must provide Applicants' with extrinsic evidence to establish that an RFID identification tag code field is inherently disclosed in Reber. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). As explained above, neither the First Office Action nor the Final Office Action makes clear that the "an RFID identification tag code field" is necessarily present in Reber's food storage apparatus and methods and systems for monitoring a food item. Moreover, neither the First Office Action nor the Final Office Action shows that one of ordinary skill would recognize "an RFID identification tag code field" in Reber's food storage apparatus and methods and systems for monitoring a food item. Because neither the First Office Action nor the Final Office Action demonstrate that Reber anticipates Applicants' claims, Applicants maintain their

traversal of the rejections under 35 U.S.C. § 102 and respectfully request the withdrawal of the rejections.

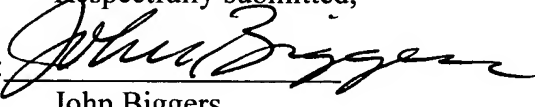
**Conclusion**

For the reasons set forth in detail above in this Brief, Applicants traverse each of the arguments in the Final Office Action responding to Applicants' Response to First Office Action. Applicants' therefore respectfully traverse each rejection individually of claims 1-27.

In view of the forgoing arguments, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

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APPENDIX OF CLAIMS  
ON APPEAL IN PATENT APPLICATION OF  
WILLIAM K. BODIN, *ET AL.*, SERIAL NO. 10/062,325

CLAIMS

What is claimed is:

1. A method of inventory control comprising the steps of:

providing inventory item attributes comprising data elements in computer memory, wherein the inventory item attributes describe an inventory item, the inventory item has an RFID identification tag having an RFID identification tag code, and the inventory item attributes comprise:

an RFID identification tag code field,  
a control value,  
an acceptable control value range, and  
an out of range action;

detecting changes in the inventory item attributes, wherein detecting changes in inventory item attributes includes reading, through an RFID reader, the RFID identification code from the RFID tag associated with the inventory item;

recording detected changes in inventory item attributes;

comparing the control value and the acceptable control value range; and

taking action in dependence upon the result of the comparing and the out of range action.

2. The method of claim 1 wherein the steps of detecting changes, recording detected changes, comparing the control value and the acceptable control value range, and taking action are carried out through Java servlets in at least one OSGI-compliant service bundle installed and operating in an OSGI-compliant service gateway.

3. The method of claim 1 wherein:

the inventory item attributes further comprise a control value unit field set to 'pounds';

detecting changes includes reading the weight of the inventory item from a scale; and

recording detected changes comprises storing the weight of the inventory item in the control value.

4. The method of claim 1 wherein:

the inventory item attributes further comprise a control value unit field set to 'freshness';

detecting changes in the inventory attributes of the inventory item further comprises:

reading from a clock the time when the inventory item is removed from a refrigerator,

reading the temperature from a kitchen thermometer,

reading from the clock the time when the inventory item is returned to the refrigerator, and

calculating a freshness coefficient in dependence upon the time when removed, the time when returned, and the temperature; and

recording detected changes comprises storing the freshness coefficient in the control value.

5. The method of claim 1 wherein:

the inventory item attributes further comprise a control value unit field set to 'utilization';

detecting changes in the inventory attributes of the inventory item includes detecting that the inventory item has been removed from and returned to an inventory storage location; and

recording detected changes comprises incrementing the control value, wherein the control value represents the number of times the inventory item has been utilized.

6. The method of claim 1 wherein:

the inventory item comprises a quantity of separate items;

the inventory item attributes further comprise a control value unit field set to 'count';

detecting changes in the inventory attributes includes detecting that one of the separate items has been removed from inventory; and

recording detected changes comprises decrementing the control value, wherein the control value represents the quantity of separate items.

7. The method of claim 1 wherein:

the inventory item attributes further comprise:

a control value unit field set to 'days', and  
an inventory date representing the date when the inventory item entered inventory;

detecting changes comprises:

reading from a clock the current date, and

calculating the age of the inventory item in dependence upon the current date and the inventory date; and

recording detected changes comprises storing the age of the inventory item in the control value.

8. The method of claim 1 wherein taking action comprises emailing an order to a vendor to reorder the inventory item when the control value is outside the acceptable control value range.

9. The method of claim 1 wherein taking action comprises emailing a message to a user advising the user to discard the inventory item when the control value is outside the acceptable control value range.

10. The method of claim 1 wherein taking action comprises sending, through HTTP and through a vendor service gateway directly to a vendor's online order system, an HTML order for the inventory item when the control value is outside the acceptable control value range.

11. A system of inventory control comprising:

means for providing inventory item attributes comprising data elements in computer memory, wherein the inventory item attributes describe an inventory item, the inventory item has an RFID identification tag having an RFID identification tag code, and the inventory item attributes comprise:

an RFID identification tag code field,  
a control value,  
an acceptable control value range, and  
an out of range action;

means for detecting changes in the inventory item attributes, wherein means for detecting changes in inventory item attributes include means for reading, through an RFID reader, the RFID identification code from the RFID tag associated with the inventory item;

means for recording detected changes in inventory item attributes;

means for comparing the control value and the acceptable control value range;  
and

means for taking action in dependence upon the result of the comparing and the out of range action.

12. The system of claim 11 wherein the means for detecting changes, means for



recording detected changes, means for comparing the control value and the acceptable control value range, and means for taking action are carried out through Java servlets in at least one OSGI-compliant service bundle installed and operating in an OSGI-compliant service gateway.

13. The system of claim 11 wherein:

the inventory item attributes further comprise a control value unit field set to 'pounds';

means for detecting changes includes means for reading the weight of the inventory item from a scale; and

means for recording detected changes comprises means for storing the weight of the inventory item in the control value.

14. The system of claim 11 wherein:

the inventory item attributes further comprise a control value unit field set to 'freshness';

means for detecting changes in the inventory attributes of the inventory item further comprises:

means for reading from a clock the time when the inventory item is removed from a refrigerator,

means for reading the temperature from a kitchen thermometer,

means for reading from the clock the time when the inventory item is returned to the refrigerator, and

means for calculating a freshness coefficient in dependence upon the time when removed, the time when returned, and the temperature; and

means for recording detected changes comprises means for storing the freshness coefficient in the control value.

15. The system of claim 11 wherein:

the inventory item attributes further comprise a control value unit field set to 'utilization';

means for detecting changes in the inventory attributes of the inventory item includes means for detecting that the inventory item has been removed from and returned to an inventory storage location; and

means for recording detected changes comprises means for incrementing the control value, wherein the control value represents the number of times the inventory item has been utilized.

16. The system of claim 11 wherein:

the inventory item comprises a quantity of separate items;

the inventory item attributes further comprise a control value unit field set to 'count';

means for detecting changes in the inventory attributes includes means for detecting that one of the separate items has been removed from inventory; and

means for recording detected changes comprises means for decrementing the control value, wherein the control value represents the quantity of separate items.

17. The system of claim 11 wherein:

the inventory item attributes further comprise:

a control value unit field set to 'days', and  
an inventory date representing the date when the inventory item entered inventory;

means for detecting changes comprises:

means for reading from a clock the current date, and

means for calculating the age of the inventory item in dependence upon the current date and the inventory date; and

means for recording detected changes comprises means for storing the age of the inventory item in the control value.

18. The system of claim 11 wherein means for taking action comprises means for emailing an order to a vendor to reorder the inventory item when the control value is outside the acceptable control value range.
19. The system of claim 11 wherein means for taking action comprises means for emailing a message to a user advising the user to discard the inventory item when the control value is outside the acceptable control value range.
20. The system of claim 11 wherein means for taking action comprises means for sending, through HTTP and through a vendor service gateway directly to a vendor's online order system, an HTML order for the inventory item when the

control value is outside the acceptable control value range.

21. A computer program product of inventory control comprising:

a recording medium;

means, recorded on the recording medium, for providing inventory item attributes comprising data elements in computer memory, wherein the inventory item attributes describe an inventory item, the inventory item has an RFID identification tag having an RFID identification tag code, and the inventory item attributes comprise:

an RFID identification tag code field,  
a control value,  
an acceptable control value range, and  
an out of range action;

means, recorded on the recording medium, for detecting changes in the inventory item attributes, wherein means, recorded on the recording medium, for detecting changes in inventory item attributes include means for reading, through an RFID reader, the RFID identification code from the RFID tag associated with the inventory item;

means, recorded on the recording medium, for recording detected changes in inventory item attributes;

means, recorded on the recording medium, for comparing the control value and the acceptable control value range; and

means, recorded on the recording medium, for taking action in dependence upon the result of the comparing and the out of range action.

22. The computer program product of claim 21 wherein the means for detecting changes, means for recording detected changes, means for comparing the control value and the acceptable control value range, and means for taking action are carried out through Java servlets in at least one OSGI-compliant service bundle installed and operating in an OSGI-compliant service gateway.
23. The computer program product of claim 21 wherein:
- the inventory item attributes further comprise a control value unit field set to 'pounds';
- means, recorded on the recording medium, for detecting changes includes means, recorded on the recording medium, for reading the weight of the inventory item from a scale; and
- means, recorded on the recording medium, for recording detected changes comprises means, recorded on the recording medium, for storing the weight of the inventory item in the control value.
24. The computer program product of claim 21 wherein:
- the inventory item attributes further comprise a control value unit field set to 'freshness';
- means, recorded on the recording medium, for detecting changes in the inventory attributes of the inventory item further comprises:
- means, recorded on the recording medium, for reading from a clock the time when the inventory item is removed from a refrigerator,

means, recorded on the recording medium, for reading the temperature from a kitchen thermometer,

means, recorded on the recording medium, for reading from the clock the time when the inventory item is returned to the refrigerator, and

means, recorded on the recording medium, for calculating a freshness coefficient in dependence upon the time when removed, the time when returned, and the temperature; and

means, recorded on the recording medium, for recording detected changes comprises means, recorded on the recording medium, for storing the freshness coefficient in the control value.

25. The computer program product of claim 21 wherein:

the inventory item attributes further comprise a control value unit field set to 'utilization';

means, recorded on the recording medium, for detecting changes in the inventory attributes of the inventory item includes means, recorded on the recording medium, for detecting that the inventory item has been removed from and returned to an inventory storage location; and

means, recorded on the recording medium, for recording detected changes comprises means, recorded on the recording medium, for incrementing the control value, wherein the control value represents the number of times the inventory item has been utilized.

26. The computer program product of claim 21 wherein:

the inventory item comprises a quantity of separate items;

the inventory item attributes further comprise a control value unit field set to 'count';

means, recorded on the recording medium, for detecting changes in the inventory attributes includes means, recorded on the recording medium, for detecting that one of the separate items has been removed from inventory; and

means, recorded on the recording medium, for recording detected changes comprises means, recorded on the recording medium, for decrementing the control value, wherein the control value represents the quantity of separate items.

27. The computer program product of claim 21 wherein:

the inventory item attributes further comprise:

a control value unit field set to 'days', and  
an inventory date representing the date when the inventory item entered inventory;

means, recorded on the recording medium, for detecting changes comprises:

means, recorded on the recording medium, for reading from a clock the current date, and

means, recorded on the recording medium, for calculating the age of the inventory item in dependence upon the current date and the inventory date; and

means, recorded on the recording medium, for recording detected changes comprises means, recorded on the recording medium, for storing the age of the inventory item in the control value.

28. The computer program product of claim 21 wherein means, recorded on the recording medium, for taking action comprises means, recorded on the recording medium, for emailing an order to a vendor to reorder the inventory item when the control value is outside the acceptable control value range.
29. The computer program product of claim 21 wherein means, recorded on the recording medium, for taking action comprises means, recorded on the recording medium, for emailing a message to a user advising the user to discard the inventory item when the control value is outside the acceptable control value range.
30. The computer program product of claim 21 wherein means, recorded on the recording medium, for taking action comprises means, recorded on the recording medium, for sending, through HTTP and through a vendor service gateway directly to a vendor's online order system, an HTML order for the inventory item when the control value is outside the acceptable control value range.